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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,196	02/27/2002	Sunil V. Thakur	SUNI	1473

7590 09/27/2004

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/085,196

Applicant(s)

THAKUR ET AL. *ST*

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/27/02
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____  |

### **Detailed Action**

1. This Office Action is responsive to the original Application. Claims 1-11 are presented for examination.

### ***Specification***

2a. The disclosure is objected to because of the following informalities: This application claims priority to US Application SN. 09/154,906. This is error because this latter refers to an unrelated **SLAB PLUMBING SYSTEM**. This application also claims priority to US Application 09/375934 which is a continuation of PCT/US00/22503. Inclusion of SN 09/375934 in the first paragraph of the specifications is required.

### **Claims Objections**

2b. Claim 8: 'the computer' lack of antecedent basis. It is interpreted as the means at the vendor location.

### **Claim rejections. 35 U.S.C. 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

4. **Claims 1-4, 7-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kepecs, US 6009411 hereinafter Kepecs in view of Williams US 6075971, herein Williams.**

Kepecs generally discloses a method and system for distributing and redeeming electronic promotions to a consumer through the Internet is provided. An account which is associated with a unique key is maintained for each consumer account. Access is permitted to the consumer account upon presentation of the unique key over the Internet. The consumer is presented discount or other promotional choices of items available in at least one store associated with the key, or a collection of such stores, over the Internet and the selections of the discount or promotional choices made by the consumer over the Internet are recorded. Upon purchase of items at the associated store by the consumer, such data are received, and the selections and purchases are reconciled to record a credit in the customer account. No consumer action other than the selection of promotions desired is required for item purchase.

Thus as to claims 1, 2, 8,10,11, Kepecs discloses:

A business system (Figs 1,2,3 and associated text) comprising a magnetic strip card with consumer identifying information encoded thereon, said information identifying a consumer desiring to conduct a transaction with a vendor (col 7 l. 27 et seq.; *For the consumer's convenience, the DAP may issue an identification card to each consumer with a magnetic or bar code for his Key. The card allows the consumer to quickly identify his Key and account at a store with a UPC scanner 26 or ATM reader 27. The card might also show the Key so that the consumer can type in his Key. Alternatively, for additional security, the consumer's identification card may carry an encrypted or hidden identification code (such as a PIN) before the consumer's Key is validated after being read at a store, for example. Alternatively, the DAP may simply rely on Keys already obtained*

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*by the store or credit card agency."*

*" The consumer may provide his Key with a card containing the Key in the form of magnetically-encoded data or bar code data, which is simply scanned in. The Key may be in a separate card, or in a credit/debit/smart card which also includes the Key data. A retailer's loyalty card can include the Key data, which might simply be the store's loyalty card ID. The Key can also be provided by the consumer by simply entering the Key at an ATM reader 27 (using a template, such as those on push-button telephones) or letting the store clerk enter the Key at the register 21. More exotic forms include biometric identification. In any case, the DAP software at the register 21, and possibly at the master store computer 23, records the Key and the transaction data").*

a host system remote from the vendor location that maintains information about said vendor, (Fig 1-3 and associated text, especially DAP;col 3 l. 30 et seq.; col 7 l. 60 et seq-col 10 l. 67)

an apparatus for reading the consumer identifying information on the magnetic said apparatus interconnected with and in communication with the host system for ascertaining any applicable discounts of said discounts (Fig 2 and associated text, esp. ATM, UPC, col 4 l. 48-67, ) , and

means apart from the magnetic strip card for applying any applicable discount of said discounts related to said transaction for the benefit of said consumer (Fig 1-3 and associated text, cols3-10; col 11 l. 1-21 and 45-55 to col 12 l. 50. )

means at the host system for receiving from the vendor transaction information about said transaction, and

means at the host system for storing said information. (figs 2 and 3 and accompanying text; col 10 . 59-col 13 l. 22).

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Kepecs does not disclose applying the discount without a selection from the consumer of any said applicable discount, and without requiring consumer awareness of any said applicable discount.

However, Williams discloses a method and apparatus for providing and monitoring coupons via a network wherein coupons may be downloaded to a user's system automatically or on demand.

It would have been obvious to one skilled in the art at the time the invention was made to add Williams to Kepecs because both references deal with coupons and the automatic download thereof is an art recognized equivalent for delivering coupons on demand as taught by Williams.

Claim 3. Kepecs discloses the system of claim 1. Further Kepecs at least suggests means for calculating a future discount for the consumer based on the transaction information. (See col 8 l. 12-46: targeting individual consumers based on past purchase histories)

Claim 4. Kepecs discloses the system of claim 3 thus implicitly discloses means for providing the consumer with information about the future discount (see claim 3 above) .

Claim 7. The system of claim 1 is disclosed as above. Further, Kepecs does disclose using the Internet to contact the host system (fig 1 and associated text).

**5. Claims 5-6, and 9 are rejected under 35 USC 103(a) as unpatentable over Kepecs in view of Williams as applied to claim 3 above and further in view of Hoffman US 5297026.**

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## Claims 5 and 6 .

As per claims 5-6 (dependent on claim 3), Kepecs does not disclose means for calculating an amount to a retirement account contribution for a consumer based on the transaction information(claim 3) or based on the calculated amount (Claim 6). However, Hoffman US 5297026 disclose giving rewards for purchases in the form of a percentage of the amount spent (claim 6) deposited in a customer account earning interest at a higher rate.(abstract). Thus one skilled in the incentives arts would have known from Hoffman's teachings regarding the use of such incentives accounts to include retirement accounts such as to lure naïve aging baby boomers to spend more. As to the basis of such reward being the nature of the transaction (claim 5) such marketing technique is well-known and obvious (e.g. use MasterCard, earn more rewards; buy particular product, earn more).

As to claim 9, Kepecs discloses means for determining a pertinent geographical area for the consumer ( col 9 l. 2-5;col 7 l. 60- col 8 l. 22.; col 9 l. 30 et seq. "The consumer selects the desired discounts, and if required, at which stores"; geographic limitations and sellers information)

means for automatically determining the pertinent geographic area based on information about a consumer (col 11 l. 4-10 : the computer infers customer likely store selection from his purchasing history). Hoffman further discloses the additional features as explained in claims 5 and 6 for the same motivation.

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**Conclusion**

6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is (703) 305-0571. The examiner can normally be reached on Tues-Wed from 9:00 AM – 6:00 PM. The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. Facsimile transmissions to this Group (TC 2100) may be directed to :

After-final (703) 746-7238

Official (703) 746-7239

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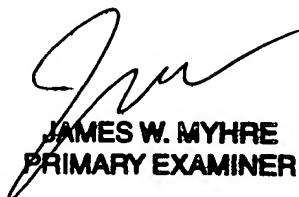
Non-Official/Draft (703) 746-7240

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900 .

September 15, 2004

KHL

KHL



**JAMES W. MYHRE**  
**PRIMARY EXAMINER**